

REMARKS

This Application has been carefully reviewed in light of the Office Action electronically sent on May 18, 2010. At the time of the Office Action, Claims 1, 4-9, 12-17, and 20-25 were pending in this Application. Claims 1, 4-9, 12-17, and 20-25 were rejected. Claims 17 and 25 have been amended. Applicant respectfully requests reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 112

Claims 1, 4-9, 12-17, and 20-25 were rejected by the Examiner under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Applicant traverses this rejection and respectfully requests allowance of the claims.

The Examiner asserts that “there is no disclosure for a supplier communicating techniques for interfacing with the feature interfaces,” because the specification discloses information such as precise features and “techniques with those features,” and not feature interfaces.

Applicant respectfully disagrees, and submits that the application complies with the written description requirement. For example, the application discloses on page 16 that a service may include service features, a description, and feature interfaces; the description provides a number of descriptors with information about the service, including “detailing mechanisms for accessing and interfacing with feature interfaces.” Application at 16. The application goes on to disclose that, “During operation... organization agent 22 may contact service 18 and query information within description 54. In response, service 18 may provide this information to organization agent 22.... The information provided may also include... techniques for accessing and interfacing with feature interfaces.” *Id.* Thus, the application discloses a supplier communicating techniques for interfacing with the feature interfaces.

Claims 1, 4-9, 12-17, and 20-25 were rejected by the Examiner under 35 U.S.C. §112, second paragraph, as being indefinite and failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant traverses this rejection and requests allowance of the claims.

The Examiner argues that, as discussed above, the specification does not provide support for techniques for interfacing with the interfaces. The Examiner argues that it is unclear what the difference is between feature interfaces and techniques for interfacing with features.

Applicant respectfully disagrees, and submits that the application is not indefinite and complies with the requirement to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. As shown above, the specification supports the claimed limitation. In addition, the application discloses on page 16 that: “Feature interfaces 56 enable other entities, such as agent 40, to interface with functions provided by service features 52.” Application at 16. The distinction between the service provider identifying techniques for interfacing with the feature interfaces, and merely providing the interfaces themselves may be useful. For example, if an entity accessing the service provider is unaware of the nature of the feature interface, or is unaware of what techniques or mechanisms may be used to access such a feature interface, then the entity may not be able to successfully access the service. One way of informing the entity accessing the service provider is for the service provider to inform the entity of one or more techniques by which the service interfaces may be used.¹ Consequently, the claims particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Furthermore, the Examiner argues that Claim 25 contains means (or step) plus function limitations that invoke 35 U.S.C. § 112, sixth paragraph, but that the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed invention such that one of ordinary skill in the art would recognize what structure, material or acts perform the claimed function. The Examiner argues that the “means” appears to be the organization agent

¹ This concept will be revisited later, in the discussion regarding patentability under 35 U.S.C. § 103.

which is a software program, and therefore the means may be interpreted to be software per se. The Examiner then states that Applicant is required to amend the claims to eliminate the mean plus function limitation, amend the written description to clearly link structure, material, or acts to the claimed function, or to state, on the record, where the corresponding structure, material, or acts are set forth in the written description.

The Federal Circuit has held that, in a means-plus-function claim, in which the disclosed structure is a processor programmed to carry out an algorithm, “the disclosed structure is not the general purpose computer, but rather the special purpose computer programmed to perform the disclosed algorithm.” *WMS Gaming Inc. v. International Game Technology*, 184 F.3d 1339, 1349 (Fed. Cir. 1999). The structure disclosed for the means for the limitations was a processor programmed to perform the algorithm referenced in the claims. The specification of the current application discloses an algorithm for which a processor is programmed to execute. Applicant, without waiver or limitation, points the Examiner to Figure 4, a flowchart illustrating a method for an organization agent to provide automated organization management of services for an organization. Thus, the specification discloses corresponding structure, material, or acts performing the claimed function. Applicant respectfully traverses this rejection and seeks allowance of Claim 25.

Rejections under 35 U.S.C. § 101

Claims 17 and 20-24 were rejected by the Examiner under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Applicant amends Claims 17 and 25 to overcome these rejections and respectfully request full allowance of Claims 17 and 20-24 as amended.

The Examiner suggested amended the preamble to include “non-transitory” or “stored.” Applicant has amended Claim 17 to include the preamble: “A non-transitory computer readable medium encoded with logic for automated management of business services, the logic operable

when executed to perform the steps of...” Claims 20-24 depend from Claim 17. Thus, Applicant respectfully requests allowance of the claims as amended.

Claim 25 was rejected by the Examiner under 35 U.S.C. §101 because it lacks the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 36 U.S.C. 101. Applicant traverses this rejection and respectfully requests full allowance of Claim 25 as amended.

The Examiner argues that Claim 25 lacks the necessary physical articles or objects to constitute a machine or manufacture. The Examiner further argues that Claim 25 was at best “function descriptive material per se,” which is nonstatutory under *In re Warmerdam*, 33 F.3d 1354, 1360 (Fed. Cir. 1994). The Examiner also argues that claiming abstract ideas stored on a computer-readable medium (nonfunctional descriptive material) does not make the invention statutory, and citing *Diamond v. Diehr*, 450 U.S. 175, 185-186 (1981).

Applicant respectfully disagrees that Claim 25 lacks the necessary physical articles or objects to constitute a machine or manufacture. For example, Claim 25 contains several elements directed at physical articles or objects, including “A system for *automated* management,” “an *organizational database*,” “a *network address* for each of a plurality of service providers,” and a “service registry.” Further, the application discloses that service providers “offer *machine readable interfaces* that enable structured queries to access and interact with information regarding services.” Application at 6. Claim 25, as amended, also contains the limitations “wherein the service registry and each of the plurality of service providers are *coupled to a communications network*,” and “communicating with the service provider *via the communications network*.” Thus, Claim 25 contains the necessary physical articles or objects to constitute a machine or manufacture.

In addition, the legal authorities cited by the Examiner do not yield the Examiner’s asserted conclusions. The Federal Circuit in *In re Warmerdam* merely stated that the only embodiment of a claimed *method* consisted of steps which were “essentially mathematical in nature.” 33 F.3d at 1360. No analysis of a means-plus-function claim was explored, and no

delineations of various types of descriptive material was made, as the Examiner argues. As discussed above, Claim 25 is not a series of steps that are essentially mathematical in nature. In the same way, the Supreme Court's holding in *Diehr* is inapposite to the present issues. Thus, Applicant traverses the rejection and seeks allowance of Claim 25.

Rejections under 35 U.S.C. §103

Claims 1, 4-7, 9, 12-15, 17, 20-23, and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication 2003/0023499 filed by Rajarshi Das ("*Das*") in view of U.S. Patent Application Publication 2001/0051913 filed by Avinash Vashistha ("*Vashistha*") in view of U.S. Patent Application Publication 2002/0046157 by Neal Solomon ("*Solomon*"). Applicant respectfully traverses and submits the cited art combinations, even if proper, which Applicant does not concede, does not render the claimed embodiment of the invention obvious.

Claims 8, 16, and 24 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Das* in view of *Vashistha* in view of *Solomon* in further view of U.S. Publication No. 2002/0184527 filed by Jon Andre Chun et al ("*Chun*"). Applicant respectfully traverses and submits the cited art combinations, even if proper, which Applicant does not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with

some rational underpinning to support the legal conclusion of obviousness.” *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on ex post reasoning. *KSR*, 127 S.Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 127 S.Ct. at 1741).

The Examiner argues that *Das* discloses the limitation “the service provider identifying at least techniques for interfacing with the feature.” The Examiner cites as evidence that *Das* discloses “the invention makes use of information indicating the interoperability mechanisms that the vendor supports,” [0057]; “the system obtains interoperability mechanism information from the UDDI of businesses,” [0058]; “the purchasing system sends a specification... to a shopbot service that returns information...” [0058]; and “the system automatically negotiates purchasing transactions after examining (i.e. interfacing with) on-line catalog (i.e. a feature),” [0059]. The Examiner also notes that Applicant’s specification does not describe what the techniques for interfacing comprise, and thus the Examiner understands a technique to be any means of interacting with a feature.

Applicant respectfully disagrees and submits that the cited prior art does not disclose or teach the limitation “the service provider identifying at least techniques for interfacing with the feature interfaces” of Claim 1. Each and every piece of evidence cited by the Examiner suffers from the same flaw—they do not show that the service provider is identifying the techniques for interfacing with the feature interfaces. For example, the fact that *Das* discloses that the invention “makes use of information indicating the interoperability mechanisms” says nothing about how such information was obtained. Such information may have been previously known, hard-wired, or obtained from a third party. Nothing indicates that such information was identified by the service provider, as required by the claim limitation. Similarly, the fact that *Das* discloses “the system obtains interoperability mechanism information from the UDDI of businesses” *explicitly requires* obtaining such information from a third party, (Universal Description, Discovery, and

Integration on the web, “www.uddi.org”) and not from the service provider itself. *Das* at [0058]. Likewise, a shopbot service is even declared by *Das* to be a “third party” service. *Id.* In the case where a “system automatically negotiates purchasing transactions after examining... and on-line catalog,” *Das* makes no statement that the techniques are identified by the service provider; instead, *Das* merely states that the “present invention may examine products for purchase” and “automatically negotiate the purchasing transaction.” Nothing is disclosed about how the present invention determined how to interface with and service feature interfaces, much less that the service in question identified any suitable techniques.

Consequently, the cited prior art does not disclose or teach the limitation “the service provider identifying at least techniques for interfacing with the feature interfaces.” Thus, Claim 1 is patentable and should be allowed. Independent Claims 9, 17 and 25 contain similar limitations, and are thus likewise allowable. Dependent Claims 4-8, 12-16, and 20-24 depend from Claims 1, 9, and 17, and are thus also allowable. Applicant traverses the rejection, and seeks allowance of the Claims 1, 4-9, 12-17, and 20-25.

No Waiver

All of Applicant’s arguments and amendments are without prejudice or disclaimer. Additionally, Applicant has merely discussed example distinctions from the references relied upon. Other distinctions may exist, and Applicant reserves the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner’s additional statements. The example distinctions discussed by Applicant are sufficient to overcome the rejections asserted in the present Office Action.

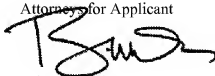
CONCLUSION

Applicant has made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicant respectfully requests reconsideration of Claims 1, 4-9, 12-17, and 20-25. as amended.

Applicant believes there are no fees due at this time; however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.322.5470.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorneys for Applicant



Brian W. Oaks
Reg. No. 44,981

Date: August 16, 2010

CORRESPONDENCE ADDRESS:

CUSTOMER NUMBER: **05073**

Tel. 512.322.5470

Fax. 512.322.8383